



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,719	09/25/2003	Wataru Yamada	117322	6414
25944	7590	08/12/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/669,719

Applicant(s)

YAMADA ET AL.

Examiner

Janis L. Dote

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☒ Newly proposed or amended claim(s) 1, 2, 5, 6 and 8-12 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1, 2, 5, 6, and 8-12.
Claim(s) objected to: _____.
Claim(s) rejected: 3 and 7.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attachment, paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700

Art Unit: 1756

1. For purposes of appeal, the proposed amendment filed on Jul. 26, 2005, will be entered upon the filing of an appeal and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal: Claims 3 and 7 would be rejected for the reasons set forth in paragraphs 6 and 8 of the final Office action mailed on Apr. 26, 2005, as set forth infra.

Paragraph 6:

Claim 3 would be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons discussed on pages 6-7 of the final Office action.

Paragraph 8:

Claims 3 and 7 would be rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0086794 A1 (Yamada) for the reasons discussed on pages 7-9 of the final Office action.

2. The rejections under 35 U.S.C. 102(b) over Japanese Patent 2001-100447 (JP'447) of claims 1-3, 5, 6, 11, and 12, and of claims 1-3, 5-7, 11, and 12, set forth in the final Office action mailed on Apr. 26, 2005, paragraphs 9 and 10,

Art Unit: 1756

respectively, would be withdrawn in response to the amendments to claims 1, 2, and 5 set forth in the amendment filed on Jul. 26, 2005, which will be entered upon the filing of an appeal. The amendments to claims 1, 2, and 5 add the limitations of claims 13-15 that the divalent group Y in formula (1) "is at least one selected from a group consisting of $-C_nH_{2n}-$, $-C_nH_{2n-2}-$, $-C_nH_{2n-4}-$, $-C_6H_4-$, $-C_6H_4-C_6H_4-$, $-NH-$, $-C_nF_{2n}-$, $-COO-$, $-S-$, $-O-$, and $-N=CH-$, where n represents an integer from 1 to 15, provided that when a divalent group containing $-S-$, $-NH-$ and $-O-$ is used for Y, such a group is used in combination with a group containing a carbon atom to constitute a divalent group containing at least one carbon atom in its main chain."

As discussed in paragraphs 9 and 10, JP'447 teaches siloxane resins that are obtained by reacting the compound (Si-1) with other components. The compound (Si-1) meets the compositional limitations of formula (1) recited in instant claims 1, 2, and 5, but for the Y divalent group. The Y divalent group in the JP'447 compound (Si-1) is $-CH_2CH_2-$ phenylene-N(phenyl)-phenylene- $-CH_2CH_2-$. The groups $-CH_2CH_2-$ and phenylene are within the scope of the Markush group recited in instant claims 1, 2, and 5. However, the group $-N(phenyl)-$ is not within the scope of the Markush group recited in instant claims 1, 2, and 5. JP'447 does not teach or suggest siloxane

Art Unit: 1756

resins having the structure of formula (1) comprising the Y divalent group recited in instant claims 1, 2, and 5.

3. (a) The objection to the specification set forth in the final Office action mailed on Apr. 26, 2005, paragraph 4, stands. Applicants' arguments as set forth in the amendment filed on Jul. 26, 2005, which will be entered upon the filing of an appeal, are not persuasive. When the amendment filed on Jul. 26, 2005, is entered upon the filing of an appeal, the amendment to the specification would not overcome the objection. The amendment does not capitalize all of the trademarks disclosed in the instant specification. For example, see page 73, line 16, of the specification, which discloses trademark "Tospearl [sic: TOSPEARL]."

(b) The rejection of claim 3 under 35 U.S.C. 112, first paragraph, stands for the reasons discussed in the final Office action mailed on Apr. 26, 2005, paragraph 6. Applicants' arguments as set forth in the amendment filed on Jul. 26, 2005, which will be entered upon the filing of an appeal, are not persuasive. Applicants assert that "it is clearly understandable from the disclosure of the original specification that the term 'a bonding hand' means 'is bonded to.' This meaning of 'a bonding hand' is particularly clear when

Art Unit: 1756

considering that Ar¹ through Ar⁵ in Formula (4) have a portion, i.e., a hand, that bonds to R¹ in Formula (2), i.e., a 'bonding hand'" Applicants further assert that "one of ordinary skill in the art understands that the term 'bonding hand' means 'is bonded to,' especially in Japan. Applicants cite portions of three Japanese patents to support their assertion.

Applicants' arguments are not persuasive. Applicants' arguments are circular. Applicants have not indicated where in the original specification, by page number and line number, there is antecedent basis for the term "bonding hand" to mean "is bonded to" as recited in instant claim 3. Furthermore, applicants' response did not provide copies of those portions of the three Japanese patents to support their assertion that the term "bonding hand" is well known to a person having ordinary skill in the art to mean "is bonded to." Finally, applicants have not provided any evidence to support the attorney argument regarding the alleged meaning (in Japanese) of the term "bonding hand."

(c) The rejection of claims 3 and 7 under 35 U.S.C. 102(e) as being anticipated by US 2004/0086794 A1 (Yamada) stands for the reasons discussed in the final Office action mailed on Apr. 26, 2005, paragraph 8. Applicants' arguments set forth in the amendment filed on Jul. 26, 2005, which will be entered upon

Art Unit: 1756

the filling of an appeal, are not persuasive. Applicants assert that Yamada is not prior art because they have perfected their claim to foreign priority under 35 U.S.C. 119 to Japanese patent application No. 2003-081472 by filing a verified English-language translation of said document on Jul. 26, 2005.

However, the translation does not provide an adequate written description of the subject matter recited in instant claims 3 and 7 as required under 35 U.S.C. 112, first paragraph, for the following reasons:

(1) In claim 3, the limitation "at least one of Ar¹ or Ar⁵ [of formula (4)] is bonded to R¹ in general formula (2)" (emphasis added) lacks antecedent basis in the translation. Applicants have not indicated where in the translation, by page number and line number, there is antecedent basis for said limitation. The translation at page 3, lines 9-11, discloses that "at least one of Ar¹ or Ar⁵ [of formula (4)] has a bonding hand with R¹ in general formula (2)." See the discussion of rejection of claim 3 under 35 U.S.C. 112 above.

(2) In claim 7, the limitation "aluminum chelate compound" lacks antecedent basis in the translation. Applicants have not indicated where in the translation there is antecedent basis for said limitation. The translation at page 60, line 18, discloses that the metal chelate can be an "organic aluminum compound."

Art Unit: 1756

The term "aluminum chelate compound" recited in instant claim 7 is broader than the disclosure in the translation because it encompasses aluminum chelate compounds that are not organic compounds.

Accordingly, applicants have not perfected their claim to foreign priority for the subject matter recited in instant claims 3 and 7.